

**REMARKS**

**I. Status of the Claims**

Claims 18, 20-28, and 30-51 are pending in this application.

**II. Rejection Under 35 U.S.C. § 103**

In the Final Office Action<sup>1</sup> dated October 29, 2007, the Examiner maintained the rejection of claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a) as unpatentable over Mitsumatsu et al., WO 99/13830 ("Mitsumatsu") in view of Oshima, JP 401009916A ("Oshima") and Sebag et al., WO 98/03155 (also U.S. Patent No. 6,162,423) ("Sebag").

See Final Office Action at 2. Applicants respectfully traverse this rejection.

In the Final Office Action, the Examiner alleges that

the combination [of Mitsumatsu and Oshima] is still obvious ... because the weight amounts of stearyl and behenyl alcohols of the two similar prior arts are within obvious ranges, and particularly because Oshima teaches using the two compounds with specific weight amount and ratio with the specific cosmetic advantages thereof. A skilled artisan still would have had a sufficient motivation to modify the teachings of ... Mitsumatsu by using the amount of the fatty alcohols as taught by Oshima in expectation of enhancing the cosmetic properties and stability of the shampoo.

Final Office Action at 2-3. As emphasized in the Response under 37 C.F.R. § 1.116 filed April 29, 2008, Applicants respectfully submit that the weight amounts of stearyl and behenyl alcohols, as disclosed in Mitsumatsu and Oshima are not within obvious ranges because the weight amounts disclosed in Mitsumatsu and Oshima are very different and, as a result, they do not suggest or render obvious the presently claimed ranges of weight amounts and weight ratio.

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<sup>1</sup> The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

In response to this argument, the Examiner asserted that

[although] the weight range of stearyl and behenyl alcohol [in Oshima] does not overlap with the weight ranges of Mistumatsu, . . . it is not clear why those ranges must overlap in order to convey to a skilled artisan that using the Oshima's weight range and weight ratio of the fatty alcohol would make a beneficial [sic] and improved hair cosmetic, when the reference clearly teaches the benefits as discussed in the rejection.

Advisory Action at 2. Applicants respectfully disagree.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6* (Sept. 2007). Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(l)*, internal citations omitted (emphasis in original). Additionally, the prior art references relied upon in a rejection must also be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983).

In the present case, Applicants respectfully submit that the Examiner has failed to consider the claimed invention and the prior art as a whole, as is required to support a rejection under § 103. Consideration of the prior art as a whole shows that Mitsumatsu fails to disclose 1) weight amounts of stearyl alcohol or behenyl alcohol that are within the range claimed by Applicants, and 2) stearyl alcohol and behenyl alcohol

present in a ratio within the range claimed by Applicants. Upon consideration of Oshima as a whole, it becomes clear that Oshima fails to remedy the deficiencies of Mitsumatsu since Oshima discloses amounts of stearyl and behenyl alcohol that are outside the claimed range. Finally, consideration of Sebag as a whole shows that this document is silent with respect to any ratio of stearyl alcohol and behenyl alcohol. Thus, if the teachings of Mitsumatsu, Oshima, and Sebag were considered as a whole when combined, the resulting composition would necessarily contain amounts of stearyl and behenyl alcohol that are outside the claimed weight percent and ration recited in independent claims 18, 47, 49, and 50.

Nevertheless, in an attempt to advance prosecution of this application, Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 of Sandrine Decoster ("the Decoster Declaration"). The Decoster Declaration sets forth a side-by-side comparison between a composition having a C18:C22 fatty acid ratio of 0.19, which is within the claimed ratio range, with a composition having a C18:C22 fatty acid ratio of 0.085, which is outside the claimed ratio range. This direct comparison shows that the viscosity of the inventive composition was less temperature dependent than the viscosity of the comparative composition. See Decoster Declaration at paragraph 5.

This direct comparison highlights the fact that similar compositions, i.e., compositions containing the same stearyl and behenyl alcohols components but in differing amounts, would not necessarily have similar properties. Nothing in the prior art relied upon by the Examiner, when considered as a whole, would have led to the expectation of variable temperature-dependant viscosities that is shown in the Decoster Declaration. Accordingly, Applicants respectfully submit that the Examiner has failed to

demonstrate that at least the C18:C22 fatty acid ratio recited in the independent claims is rendered obvious by the prior art.

In response to Applicants' previous argument regarding the components that must be present in the prior art, e.g., the triazoles of Mitsumatsu and the specific amphoteric surfactant, polypeptide, stearyl alcohol, and behenyl alcohol of Oshima, the Examiner asserts that the teaching of "additional components does not in any way teach away or mitigate motivation to use the fatty alcohols according to the Oshima invention [sic] and make improvement on the Mitsumatsu invention." Advisory Action at 2. Applicants respectfully disagree.

The proposed combination of Mitsumatsu and Oshima, upon consideration of each reference as a whole, would be limited by the requirements disclosed by each of Mitsumatsu and Oshima -- namely that the composition must contain triazoles to achieve the optical brightening required by Mitsumatsu, and the composition must contain the four essential components of Oshima (a specific amphoteric surfactant, polypeptide, stearyl alcohol, and behenyl alcohol). Since the nature of the required components of each reference are divergent, there would be no reasonable expectation for success in combining Mitsumatsu and Oshima. It is precisely this lack of expectation of success that would "teach away or mitigate motivation" to make the combination suggested by the Examiner.

Sebag does not overcome the deficiencies of either Mitsumatsu or Oshima. A composition based on the combination of Mitsumatsu, Oshima, and Sebag must still meet the requirements of Mitsumatsu and Oshima. Namely, such a combination must include the triazoles of Mitsumatsu and the four essential components of Oshima.

However, there is no reasonable expectation that such a combination would actually satisfy the requirements of either Mitsumatsu or Oshima. And there is no reasonable expectation that combining the teachings of Mitsumatsu and Oshima would successfully achieve Applicants' claimed invention.

For at least these reasons, the combination of Mitsumatsu, Oshima, and Sebag does not render obvious Applicants' claimed invention, as recited in independent claims 18, 47, 49 and 50. Applicants therefore request withdrawal of the rejection of claims 18, 20-28, and 30-51.

**III. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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